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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,072	08/28/2001	David Goodman	Poly-32	5656

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>09/941,072</p>	<p>Applicant(s)</p> <p>GOODMAN ET AL.</p>	
	<p>Examiner</p> <p>Etienne P LeRoux</p>	<p>Art Unit</p> <p>2161</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Prosecution Reopened

In view of the Appeal Brief filed on 11/12/2004, PROSECUTION IS HEREBY REOPENED. New art rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Status

Claims 1-41 are pending. Claims 1-41 are rejected as detailed below.

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the present application, the abstract comprises more than 150 words.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 19, 35 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Pat No 6,483,602 issued to Haneda.

Claims 15 and 35:

Haneda discloses:

- a) accepting one or more search parameters [Fig 12, bar code label is read, col 21, lines 7-25] 33];
- b) generating a query based on the search parameters [order data is read from user's disk, col 21, lines 7-25]
- c) accepting one or more records returned in response to the query generated [comparing identification codes, col 21, lines 7-25]
- d) rendering information associated with each of the one or more records accepted [Fig 12, extra copies of photographs are printed]

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Claim 19:

Haneda discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more records accepted corresponds to the human-readable part of the labels [Figs 8 and 9].

Claim 39:

Haneda discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more records accepted corresponds to the human-readable part of the labels [Figs 8 and 9].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-7, 10-14, 20-26, 29-34, 36 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No US 2002/0075514 issued to Wright et al (hereafter Wright) in view of US Pat No 6,483,602 issued to Haneda.

Claims 1 and 20:

Wright discloses:

- (i) determining a unique label identifier for the storage medium [label containing globally unique document identifier, paragraph 53]
- (ii) determining a unique volume label identifier for a storage medium [indexing, paragraph 53]
- (iii) writing the unique volume label onto the storage medium [document is scanned, paragraph 55]
- (iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium [Figs 9a-9e, col 59]
- c) updating a database based on files, if any, added to or deleted from the storage medium [electronically storing, paragraph 44]

Wright discloses the essential elements of the invention as noted above but does not disclose determining whether or not the storage medium has been assigned a unique label identifier. Haneda discloses determining whether or not the storage medium has been assigned a unique label identifier [col 14, lines 65-67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wright to include determining whether or not the storage medium has been assigned a unique label identifier as taught by Haneda for the purpose of creating a new portable record for a customer [col 14, lines 65-67]. The skilled artisan would have been motivated to improve the invention of Wright such that a user can take a

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disk home and playback the reduced digital images for the purpose of possibly ordering extra prints [col 18, lines 1-20].

Claim 2:

The combination of Wright and Haneda discloses the elements of claim 1 as noted above and furthermore, Haneda discloses d) synchronizing the database with a database on a device apart from the read/write machine [Fig 2, 36]

Claim 3:

The combination of Wright and Haneda discloses the elements of claims 1 and 2 as noted above and furthermore, Haneda discloses wherein the read/write machine is a personal computer [Fig 2, 30] and the device is a handheld device [paragraph 46]

Claim 4:

The combination of Wright and Haneda discloses the elements of claims 1-3 as noted above and furthermore, Haneda discloses wherein the device is untethered handheld device [paragraph 14 – wireless].

Claim 5:

The combination of Wright and Haneda discloses the elements of claim 1 as noted above and furthermore, Haneda discloses wherein the read/write machine is a computer with at floppy disk drive [Fig 1, 16]

Claim 6:

The combination of Wright and Haneda discloses the elements of claim 1 as noted above and furthermore, Haneda discloses wherein the label based on the unique label identifier is a bar code label [Fig 12]

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Claim 7:

The combination of Wright and Haneda discloses the elements of claim 1 as noted above and furthermore, Haneda discloses wherein the act of determining a unique volume label is based in part on state information accessible to the read/write machine [col 15, lines 1-50]

Claims 10 and 29:

The combination of Wright and Haneda discloses the elements of claims 1 and 20 as noted above and furthermore, Haneda discloses d) accepting information read from a label associated with the storage medium without reading the storage medium; e) converting the accepted information into a database key; f) requesting records from a database instance using the database key; g) accepting records in response to the request; and h) rendering information about the accepted records [Fig 2 and col 19, lines 7-20]

Examiner notes that Haneda does not specifically disclose the above method steps but the above method steps would have been obvious to one of ordinary skill in the art because using a bar code scanner to provide an input for searching a database for information related to the bar code is well-known and accepted in the art. In the situation of on-line shopping the above method steps are very well-known. A shopper can scan a bar code on a grocery item, the host computer converts the bar code into a search term corresponding to a record which is stored in the database. The host computer searches the database, and if successfully finds a match for the search term, provides the information back to the shopper who is able to read the information on the screen of his/her personal computer.

Claims 11 and 30:

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The combination of Wright and Haneda discloses the elements of claims 1, 10, 20 and 29 as noted above and furthermore, Haneda discloses wherein the label associated with the storage medium is a bar code and wherein the information read from the label is accepted from the bar code scanner [Fig 2]

Claims 12 and 31:

The combination of Wright and Haneda discloses the elements of claims 1, 10, 20 and 29 as noted above and furthermore, Haneda discloses wherein the information about the accepted records rendered includes file names [Fig 14]

Claims 13 and 32:

The combination of Wright and Haneda discloses the elements of claims 1, 10, 12, 20, and 29 as noted above, and furthermore, Stevens discloses wherein the accepted information read from a label associated with the storage medium is read by a handheld device, and the information about the accepted records is rendered on the handheld device [paragraph 39].

Claims 14:

The combination of Wright and Haneda discloses the elements of claims 1, 10, 12 and 13 as noted above and furthermore, Haneda discloses wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld device [Fig 2, col 19, lines 7-20].

Claim 21:

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The combination of Wright and Haneda discloses the elements of claim 20 as noted above and furthermore, Haneda discloses d) synchronizing the database with a database on a device apart from the read/write machine [Fig 2, 36]

Claim 22:

The combination of Wright and Haneda discloses the elements of claims 20 and 21 as noted above and furthermore, Haneda discloses wherein the read/write machine is a personal computer [Fig 2, 30] and the device is a handheld device [paragraph 46]

Claim 23:

The combination of Wright and Haneda discloses the elements of claims 20 and 21 as noted above and furthermore, Haneda discloses wherein the device is untethered handheld device [paragraph 14 – wireless].

Claim 24:

The combination of Wright and Haneda discloses the elements of claim 20 as noted above and furthermore, Haneda discloses wherein the read/write machine is a computer with a floppy disk drive [Fig 1, 16]

Claim 25:

The combination of Wright and Haneda discloses the elements of claim 20 as noted above and furthermore, Haneda discloses wherein the label based on the unique label identifier is a bar code label [Fig 12]

Claim 26:

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The combination of Wright and Haneda discloses the elements of claim 20 as noted above and furthermore, Haneda discloses wherein the act of determining a unique volume label is based in part on state information accessible to the read/write machine [col 15, lines 1-50]

Claim 33:

The combination of Wright and Haneda discloses the elements of claims 20 and 29 as noted above and furthermore, Haneda discloses the database [Fig 1, 10]

Claim 34:

The combination of Wright and Haneda discloses the elements of claims 20, 29 and 33 as noted above and furthermore, Stevens discloses synchronizing the database with a database maintained by a separate machine which created the storage medium [Fig 1, paragraph 36]

Claim 36:

The combination of Wright and Haneda discloses the elements of claim 35 as noted above and furthermore Stevens discloses e) accepting information read from the machine-readable labels, f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [Fig 1, paragraph 33].

Claim 40:

The combination of Wright and Haneda discloses the elements of claim 1 as noted above and furthermore, Haneda discloses wherein if the storage medium has not been assigned a unique volume label and a unique identifier then further, generating a label based on the unique label identifier and fixing the generated label to the storage medium without storing it on the storage medium [Fig 12, col 21, lines 5-20]

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Claim 41:

The combination of Wright and Haneda discloses the elements of claim 20 as noted above and furthermore, Haneda discloses wherein if the storage medium has not been assigned a unique volume label and a unique identifier then further, generating a label based on the unique label identifier and fixing the generated label to the storage medium without storing it on the storage medium [Fig 12, col 21, lines 5-20]

Claims 8 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wright and Haneda and further in view of US Pat No 5,119,291 issued to Flannagan et al (hereafter Flannagan), as best examiner is able to ascertain.

Claim 8:

The combination of Wright and Haneda discloses the elements of claims 1 and 7 as noted above but does not disclose wherein the state information is a count sequence. Flannagan discloses wherein the state information is a count sequence [col 12, lines 1-8]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Haneda and Stevens to include wherein the state information is a count sequence as taught by Flannagan for the purpose of indicating the number of versions in the file [col 12, line 7].

Claim 27:

The combination of Wright and Haneda discloses the elements of claim 20 as noted above but does not disclose wherein the state information is a count sequence. Flannagan discloses wherein the state information is a count sequence [col 12, lines 1-8]. It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Haneda and Stevens to include wherein the state information is a count sequence as taught by Flannagan for the purpose of indicating the number of versions in the file [col 12, line 7].

Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wright and Haneda and further in view of US Pat No 4,864,616 issued to Pond et al (hereafter Pond), as best examiner is able to ascertain.

Claim 9:

The combination of Wright and Haneda discloses the elements of claim 1 as noted above but does not disclose wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium [col 3, lines 35-55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wright and Haneda to include wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium as taught by

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Pond for the purpose of positively identifying a file in storage such that it can be quickly and accurately retrieved.

Claim 28:

The combination of Wright and Haneda discloses the elements of claim 20 as noted above but does not disclose wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium [col 3, lines 35-55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Haneda and Stevens to include wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium as taught by Pond for the purpose of positively identifying a file in storage such that it can be quickly and accurately retrieved.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Haneda and further in view of US Pat No 5,971,279 issued to Raistrick et al (hereafter Raistrick).

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Claim 16:

Haneda discloses the elements of claim 15 as noted above and furthermore Haneda discloses e) accepting information read from the machine-readable labels [Fig 12, col 21, lines 6-20] but Haneda does not disclose f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans. Raistrick discloses if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans as taught by Raistrick for the purpose of providing the user with positive indication that a bar code has been successfully read.

Claim 17:

Haneda discloses the elements of claims 15 and 16 as noted above but does not disclose g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans. Raistrick discloses g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans [Fig 3]. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to modify the combination of Stevens and Haneda to include g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans as taught by Raistrick for the purpose of assisting the visually impaired.

Claim 18:

The combination of Haneda and Raistrick discloses the elements of claims 15-17 as noted above and furthermore, Raistrick discloses wherein the first indicator is a first audible sound, and the second indicator is a second audible sound [Fig 3].

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wright and Haneda and further in view of US Pat No 5,971,279 issued to Raistrick et al (hereafter Raistrick).

Claim 37:

The combination of Wright and Haneda discloses the elements of claims 35 and 36 as noted above but does not disclose g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans. Raistrick discloses g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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combination of Wright and Haneda to include g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans as taught by Raistrick for the purpose of assisting the visually impaired.

Claim 38:

The combination of Wright, Haneda and Raistrick discloses the elements of claims 35-37 as noted above and furthermore, Raistrick discloses wherein the first indicator is a first audible sound, and the second indicator is a second audible sound [Fig 3].

Response to Arguments

Applicant's arguments filed 11/12/2004 have been fully considered and are partially persuasive. However, examiner maintains the present condition of the claims is not sufficient for appeal. Examiner has reopened prosecution such that the indefiniteness of the claim language can be addressed and hopefully resolved. Examiner urges applicant to include one or more specific features of the present invention in the claim language in order to produce allowable subject matter such that the present application can be issued. Submitting the application to the Board of Appeals will not place the present application in condition for allowance. Applicant is urged to include specific details of the present invention in the claim language because an identifying label comprising a bar code is well-known and expected in the art. Furthermore, an identifying label on a portable computer readable medium such as a floppy disk is similarly well-known and expected in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

3/30/2005


SAFET METJAHIC
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